

**REMARKS**

This Amendment is filed in response to the Office Action mailed on October 8, 2004. All objections and rejections are respectfully traversed.

Claims 22-56 are in the case.

No new claims were added.

No claims were amended.

At Paragraphs 1-2 of the Office Action, claim 56 was rejected under 35 U.S.C. § 101 on the grounds that “Electromagnetic Signals” are non-statutory.

The invention, as set forth in representative claim 56, comprises in part:

56. Electromagnetic signals propagating on a computer network, comprising: *the electromagnetic signals carrying instructions for execution in a processor for the method of,*

receiving, at a second computer, an indication that an operator has requested that the second computer take over for a first computer;

requesting, from the second computer, that the first computer shut down;

completing service requests at the first computer pending at the time the first computer was requested to shut down;

transferring responsibilities of the first computer to the second computer; and

shutting down the first computer.

Applicant respectfully urges that the novel method steps are tangibly embodied in the electromagnetic signals propagating on the computer network. Further, Applicant respectfully urges that the embodiment of electromagnetic signals for transfer of *the electromagnetic signals carrying instructions for execution in a processor for the method of* between computers fully satisfies all requirements of 35 U.S.C. § 101, and all requirements set out in the MPEP.

That is, Applicant respectfully urges that embodiment of the instructions in electromagnetic signals meets all of the requirements of 35 U.S.C. § 101, especially as clarified by MPEP 2106 IV, B, 1(c) at page 2106 of MPEP 8th Edition Incorporating Revision No. 2. (hereinafter MPEP 2106 IV, B, 1(c)). Further, MPEP 2106 IV, B, 1(c) states, at page 2106:

“However, a signal claim directed to a practical application of electromagnetic energy is statutory regardless of its transitory nature, see *O'Reilly v. Morse* 56 U.S. at 114-19; *In re Breslow*, 616 F. 2d 516, 519-21, 205 USPQ 221, 225-26 (CCPA 1980).”

In the case *In re Breslow* claims were permitted by the Court (CCPA) to chemical species which are transient in nature, and cannot be separated out of the mixture in which

they are created. The MPEP cites this patentability of transitory phenomena in chemical reactions in support of the statement by the MPEP, “However, a signal claim directed to a practical application of electromagnetic energy is statutory regardless of its transitory nature”.

The important point for patentability is the practical application of electromagnetic energy. And a practical application of electromagnetic energy is transmission of a computer program over a computer network, where the computer program is for the practice of a novel method. This practical application of electromagnetic energy is patentable subject matter, as explained by MPEP 2106 IV, B, 1(c).

A copy of *In re Breslow* from 205 USPQ 221 is attached to this Amendment, for the convenience of the Examiner.

Applicant respectfully urges that imbedding instructions for execution on a processor in an electromagnetic signal propagating on a computer network meets the practical application requirements of 35 U.S.C. § 101 and of MPEP 2106 IV, B, 1(c), and that therefore claim 56 claims statutory subject matter.

At Paragraph 3 of the Office Action claims 22-55 were allowed.

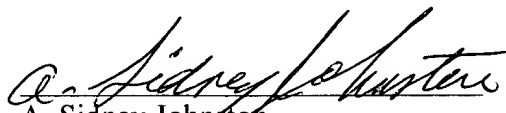
All independent claims are believed to be in condition for allowance.

All dependent claims are dependent from independent claims which are believed to be in condition for allowance. Accordingly, all dependent claims are believed to be in condition for allowance.

Favorable action is respectfully solicited.

Please charge any additional fee occasioned by this paper to our Deposit Account No. 03-1237.

Respectfully submitted,

  
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